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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,280	12/29/2000	John R. Stefanik	00339	8924
26285	7590	01/14/2005		
KIRKPATRICK & LOCKHART NICHOLSON GRAHAM LLP 535 SMITHFIELD STREET PITTSBURGH, PA 15222				
			EXAMINER YANG, CLARA I	
			ART UNIT 2635	PAPER NUMBER

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,280

Applicant(s)

STEFANIK ET AL.

Examiner

Clara Yang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/10/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 30 August 2004 with respect to claims 1 -9 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 - 9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 3, 6, and 7 of U.S. Patent No. 6,750,801 (Stefanik) in view of Hayes (U.S. Patent No. 6,223,348).

Regarding claims 1 - 9 in application no. 09/751280, Stefanik claims a remote control device, as called for in claims 1 and 7 comprising: (a) a processor (see Col. 8, line 43); (b) a motion detector in communication with the processor, wherein the processor changes a mode of operation of the remote control device from a first mode corresponding to a first consumer electronic device to a second mode corresponding to a second consumer electronic device in response to the motion detector's information (see Col. 8, lines 44 - 54); (c) a directional mode indicator in communication with the processor, the directional mode indicator for indicating the mode of operation of the device based on the information generated by the motion detector (see Col. 8, lines 46 - 51); (d) a light source in communication with the processor, wherein the light source illuminates the directional mode indicator, which is a portion of the remote control device, upon receipt of a signal from the processor (see Col. 8, lines 46 - 58); and, as called for in claim 6, (e) a storage area in communication with the processor (see Col. 9, lines 1 and 2). Because Stefanik claims that the motion detector includes one of a gravity switch and a gyroscope-type device and that the motion detector senses at least two degrees of freedom (see Col. 8, lines 63 - 67), signals generated from the motion detector must include tilt directional information. Stefanik's remote control device, as claimed, lacks (e) a transmitter in communication with the processor, (f) a receiving in communication with the processor, and (g) a smart card reader-writer in communication with the processor. Stefanik also omits claiming the limitations called for in claims 2 - 5, 8, and 9, and an electronic device comprising a transmitter, receiver, and an electronic program guide in communication with the transmitter and receiver (as required in claim 7).

In an analogous art, regarding claims 1 and 7, Hayes teaches a universal remote control with a reader slot for receiving a smart card (see Abstract). As shown in Fig. 5B, which is the

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schematic diagram of Fig. 5A with the addition of an infrared (IR) receiver, Hayes's remote control 11 comprises: (a) microprocessor 26; (b) an IR LED driver or transmitter connected to microprocessor 26; (c) IR receiver 37; and (d) smart card connector 12 that enables microprocessor 26 to read from and write to smart card 15 (see Col. 6, lines 27 - 31). Regarding claim 2, Hayes imparts smart card 15 has user-specific information and preferences stored in its memory (see Col. 9, lines 7 - 10 and 23 - 30). Regarding claim 3, Hayes states that smart card 15 is characterized as a device with a non-volatile memory and a microprocessor (see Col. 1, lines 5 - 17). Regarding claim 4, though contactless or hybrid smart cards can be used, Hayes specifies that the preferred embodiment utilize a contact type smart card (see Col. 1, lines 18 - 30). Regarding claims 5 and 9, per Hayes, smart card 15 must be inserted into a reader slot in remote control 11 (see Col. 2, lines 18 - 23 and Col. 5, lines 35 - 46 and 54 - 59). And regarding claim 8, Hayes's remote control 11 has an IR transmitter and receiver (see Fig. 5B and Col. 9, lines 31 - 35).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stefanik's remote control device as taught by Hayes because a remote control device with a smart card reader-writer enables one-time download of user-specific information and preferences stored in a smart card's memory, thereby simplifying the process of configuring a universal remote control device (see Hayes, Col. 1, lines 35 - 61).

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- ♦ U.S. Patent No. 5,705,997 (Park): Park teaches a self-illumination circuit of a hand-held remote control device and self-illumination method. The circuit includes an illuminance sensing section, a contact sensing section, a key sensing section, a

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control section, a position indicating section, a key illuminating section, and a counter. If the illuminance sensing section senses illuminance of environment and transfers an illuminance sensing signal to the control section, the position indicating section indicates position of the remote control device according a position indicating signal from the control section.

- ♦ U.S. Patent No. 6,347,290 (Bartlett): Bartlett teaches a method for processing an input command for a handheld computing device, comprising the steps of: measuring movement of the device over an interval of time with a motion sensor mounted to the device to generate a signal; analyzing the signal measured over the interval of time to determine a gesture command that corresponds to the movement of the device; and processing the gesture command to control the device as of an orientation of the device at the beginning of the interval.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clara Yang whose telephone number is (571) 272-3062. The examiner can normally be reached on 8:30 AM - 7:00 PM, Monday - Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CY



BRIAN ZIMMERMAN
PRIMARY EXAMINER